



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,580	02/16/2001	Susumu Aoyama	FUJ 17.873	4246

26304 7590 12/18/2003

KATTEN MUCHIN ZAVIS ROSENMAN  
575 MADISON AVENUE  
NEW YORK, NY 10022-2585

EXAMINER
----------

JACKSON, BLANE J

ART UNIT	PAPER NUMBER
----------	--------------

2685

DATE MAILED: 12/18/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/785,580

Applicant(s)

AOYAMA ET AL.

Examiner

Blane J Jackson

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-10 and 19-22 is/are allowed.
- 6) ☒ Claim(s) 1-6, 11 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giethoorn (U.S. Patent 6,118,859) with a view to Smith et al. (U.S. Patent 6,226,367).

As to claims 1 and 3, Giethoorn teaches a communication terminal having a display including:

A receiving unit to receive a signal including at least identifying information of a transmitter of the signal (caller ID, column 2, line 63 to column 3, line 11),

A memory to store a communication record with respect to the transmitter (column 3, lines 18-39),

A controller to control the display to display at least one of a message corresponding to a frequency of communication with the transmitter (time and date

stamp with call count for each caller, column 4, lines 23-44) when the communication terminal receives a signal including at least identifying information of the transmitter (column 2, line 63 to column 3, line 18).

Giethoorn does not teach the display of an image corresponding to a frequency of communication with the transmitter.

Smith teaches a telephone system where the user terminal uses calling line identification with a graphical icon to identify the caller (figure 6 is the created table in the telephone and column 10, lines 40-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the identity linked images as taught by Smith with the caller ID logs of Giethoorn to provide visual assistance to the receiver to quickly determine the caller identity, location or type of communication.

As to claims 2 and 4, with reference to claims 1 and 3, Giethoorn further teaches where the communication record includes a history of communication with the transmitter and the frequency of communication includes the number of times the transmitter communicates with the communication terminal within a set period of time (a log with call count and date and time for each unanswered call, column 4, lines 23-40).

As to claim 5, with respect to claim 1, Giethoorn of Giethoorn modified further teaches controlling the display to display at least one of a message and an image corresponding to a frequency of communication with the transmitter *determined by*

*using the communication record* (filling, updating and displaying the logging table in a decreasing order of counted most frequently calling parties having unanswered calls, column 4, lines 23-44).

As to claim 6, with respect to claim 5, Giethoorn of Giethoorn modified further teaches after the receiving step, updating the communication record corresponding to the received signal but if no communication record exists then storing the communication record corresponding to the received signal (column 4, lines 23-44, list shows call count left column).

4. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent 6,226,367) and further in view of Brandon (U.S. Patent 5,903,632).

As to claims 11 and 13, Smith teaches a communication terminal having a transmitting/ receiving function and a display including:

A first memory to store personal data of a user of another communication terminal with whom the communication terminal may communicate, the personal data stored corresponding to any of identifying information which identifies another communication terminal and identifying information which identifies a user of another communication terminal (column 6, lines 20-53). Smith further teaches the selective display an image selected based on the personal data in the first memory (an icon associated with the caller identification),

A controller to control the display to selectively display in any one timing of message edition to a receiver, outgoing to a receiver and after outgoing to a receiver, at least one of a message and an image selected based on the personal data in the first memory (column 9, lines 48-65).

Smith does not teach a third memory to store a record of outgoing telephone calls with application by the controller to display the message and an image based on a combination of the personal data in the first memory and outgoing communication in the third memory.

Brandon teaches a telephone (figures 1 and 2) with a third memory (fourth database) to store a record of outgoing communication, a record of outgoing communication being stored corresponding to any one of the identifying information of another communication terminal receiving an outgoing communication and the identifying information of the user of another communication terminal receiving the outgoing communication (column 6, lines 13-26, as well as a third database to store personal data of a user of another communication terminal with whom the communication terminal may communicate, column 5, lines 13-35, and a second database of incoming calls, column 5, lines 36-56). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Smith with the additional database management of outgoing calls as taught by Brandon to identify previous call completion with personal data to prepare and place return calls.

5. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giethoorn (U.S. Patent 6,118,859) and Smith et al. (U.S. Patent 6,226,367) and further in view of Makela et al. (U.S. 6,301,338).

As to claims 14 and 15, Giethoorn teaches a communication terminal having a transmitting/ receiving function, a function for the management of day and time information and a display (column 2, line 63 to column 3, line 39), the communication terminal including:

A fourth memory to store an incoming plan corresponding to any one of identifying information of another communication terminal and identifying information of a user of another communication terminal (support of unanswered phone list identified through caller ID (column 3, line 66 to column 4, line 20),

A second memory to store an incoming record with any one of day, time and both data corresponding to any one of identifying information of a transmitting communication terminal and identifying information of a user of the transmitting communication terminal (column 4, lines 23-40, display of unanswered calls by day, time with personal data),

A controller to control the display to display at least one of a message corresponding to a determination result (answered calls) where the determination result is whether the incoming plan corresponding to any one of the transmitting communication terminals and the user of the transmitting communication terminal is satisfied or not (return calls shown by blank for call count or listing is deleted, column 4,

lines 41-44). Giethoorn does not teach the display of an image with a message corresponding to a determination result.

Smith teaches a mobile telephone with a first memory to store personal data of a user of another communication terminal with whom the communication terminal may communicate, the personal data stored corresponding to any of identifying information which identifies another communication terminal and identifying information which identifies a user of another communication terminal (column 6, lines 20-53). Smith further teaches the selective display of an image selected based on the personal data in the first memory. It would have been obvious to one of ordinary skill in the art at the time of the invention to add the identity linked images as taught by Smith with the caller ID logs of Giethoorn to provide visual assistance to the receiver to quickly determine the identity, location or type of communication.

Giethoorn modified does not specifically teach a calendar function for management of day and time. Makela teaches a telephone that uses caller ID to identify the calling party and a calendar program to determine any return message and a fourth memory to store an incoming plan corresponding to any one of identifying information (column 6, lines 10-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to further recognize in the time/ date control of identity data of Giethoorn modified the calling party identification linked calendar program of Makela to base the timing and content of the return message.



As to claims 16 and 17, with reference to claims 14 and 15, Makela further teaches a communication terminal having at least an E-mail transmitting / receiving function, a calendar function for management of day and time information and a display, the communication terminal including an e-mail transmitting unit to transmit an E-mail of predetermined content to the transmitting communication terminal when it is determined that the incoming plan corresponding to any one of the transmitting communication terminals and the user of the transmitting communication terminal is not satisfied (E-mail to return the call, not personally by the called party, column 8, lines 2-5 and lines 30-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the combination of Giethoorn and Smith with the E-mail ability of Makela to provide one of many known methods of reply, voice, SMS, or facsimile to an incoming call.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent 6,226,367) with a view to Giethoorn (U.S. Patent 6,118,859).

As to claim 18, Smith teaches a communication terminal having a display including:

A first memory to store personal data of other parties, the parties being able to communicate with the communication terminal through a communication network (figure 6, column 6, lines 38-57),

A third memory to store a plurality of messages and images (column 5, lines 47-61),

A controller to select at least one of a message and an image selectively based on the personal data corresponding to the other party when the communication terminal receives information from the other party, and control the display to display the selected message and image (column 10, lines 40-46).

Smith does not teach a second memory to store a communication record of each party of the other parties respectively and for use by the controller to also select a message and an image based on a *combination* of the personal data and the communication record.

Giethoorn teaches a telecommunication system where the called party unit includes means to identify, log and display all incoming callers (column 3, line 66 to column 4, line 20). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Smith with the communication record of Giethoorn to further facilitate call management by the called party.

### ***Allowable Subject Matter***

7. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 7-10 and 19-22 are allowed.

As to claims 7, 9 and 19, the prior art made of record failed to teach a controller to control a display to selectively display, in any one timing of incoming from a

Art Unit: 2685

transmitter and after display of receiving content from a transmitter, in a case of receiving signal including at least one of the identifying information of the transmitting communication terminal and the identifying information of the user of the transmitting communication terminal, at least one of a message and an image selected based on personal data in the first memory and a record of incoming communication in the second memory.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Macaulay et al. (U.S. Patent 6,226,512) discloses a method for providing additional information about a calling party for display on the handset, the information is found in the central switching controller database. Schnarel et al. (U.S. Patent 6,389,124) discloses a user interface for screen phones monitors telephone line state information and displays user interface controls and telephone line status information. Kraft (U.S. Patent 6,424,829) discloses a method for a wireless communication terminal for handling location independent short messages. Blanchard et al. (U.S. Patent 6,408,191) discloses an arrangement for displaying message screens on a portable telephone. Amin (U.S. Patent 6,418,307) discloses a voice mail notification to a subscriber to indicate a voice mail message is waiting including the calling party number, name of the calling party and an index. Schmidt et al. (U.S. Patent 6,516,200) discloses a communication terminal supplied with an indication of incoming group calls to distinguish from other types of incoming calls. Izaki et al. (U.S. Patent

Art Unit: 2685

6,526,133) discloses a telephone with a first display of caller telephone number and the second sequential selected display image includes other display content. Watanabe (U.S. Patent 6,539,240) discloses two characters respectively representing the caller and receiver are communicated between the caller and receiver for display to both to communicate the intentions with each other while letting the self character take a specified action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blane J Jackson whose telephone number is (703) 305-5291. The examiner can normally be reached on Monday through Friday, 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (703) 305-4385. The fax phone number for the organization where this application or proceeding is assigned is (703) 812-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

BJJ



**QUOCHIEN B. VUONG  
PRIMARY EXAMINER**